

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: Sept. 9, 2021

Mailed: October 29, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Maker's Mark Distillery, Inc.

v.

Bowmaker's Whiskey Co.

—
Opposition No. 91239589
—

Richard M. Assmus, Michael D. Adams, Emily A. Nash, Daniel P. Virtue
of Mayer Brown, LLP for Maker's Mark Distillery, Inc.

Theodore A. Breiner of Breiner & Breiner, L.L.C.
for Bowmaker's Whiskey Co.

—
Before Taylor, Wellington, and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Bowmaker's Whiskey Co. ("Applicant") seeks registration on the Principal Register of the mark **BOWMAKER'S WHISKEY** (in standard characters, with "WHISKEY" disclaimed) for "distilled spirits, whiskey, bourbon" in International

Class 33.¹

Maker's Mark Distillery, Inc. ("Opposer") filed a Notice of Opposition² to registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), claiming likelihood of confusion with its registered standard character marks listed below:

MAKER'S MARK (with "MARK" disclaimed) for "whiskey" in Class 33;³

MAKER'S for "alcoholic beverages except beers; whisky" in Class 33;⁴

MAKER'S 46 for "distilled spirits; liquor" in Class 33;⁵ and

MAKER'S MARK PRIVATE SELECT (with "PRIVATE SELECT" disclaimed) for "alcoholic beverages except beers; whisky" in Class 33.⁶

Applicant, in its Answer, denied the salient allegations of the Notice of Opposition.⁷

¹ Application Serial No. 87383989 was filed on March 24, 2017, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intention to use the mark in commerce.

² 1 TTABVUE.

³ Registration No. 0678192 issued on May 5, 1959, renewed. The registration describes the mark as a "typed drawing," now known as a standard character mark. TMEP § 807.03(i) (July 2021). *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1345 n. 2 (Fed. Cir. 2010) (nomenclature changed in 2003).

⁴ Registration No. 4964096 issued on May 24, 2016.

⁵ Registration No. 3967288 issued on May 24, 2011, renewed.

⁶ Registration No. 5286883 issued on Sept. 12, 2017.

⁷ 7 TTABVUE. The Answer raises four purported "affirmative defenses" that "are not true affirmative defenses...." *U.S. Olympic Committee v. Tempting Brands*, 2021 USPQ2d 164, *4 (TTAB 2021). 7 TTABVUE 7-8. The first, asserting that Opposer fails to state a claim upon which relief can be granted, does not set forth an affirmative defense. *Id.* at *4 n.5. The proper measure would have been for Applicant to file a motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6). Applicant did not file such a motion. The second and third assert that Applicant owns and is entitled to register its applied-for mark, and that Opposer is entitled to no relief as claimed in the opposition. These are not affirmative defenses either, as they raise no "new facts and arguments that, if true, will defeat the plaintiff's or prosecution's claim, even if all allegations in the complaint are true." *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) citing BLACK'S LAW DICTIONARY, p. 430 (7th ed. 1999). And the fourth,

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 CFR § 2.122, the file of the subject application. In addition, Opposer introduced:

- Testimonial Declaration of Maker's Mark's Senior Marketing Director, Nathalie Phillips, with exhibits. (31 TTABVUE, 32 TTABVUE (confidential));
- Testimonial Declaration of Maker's Mark's Vice President of Finance, Mitch Wagner, with Exhibits, (35 TTABVUE, 33 TTABVUE (confidential));
- Testimonial Deposition Transcript of Applicant's founder, Bryan Parks, with exhibits (39 TTABVUE, 40 TTABVUE (confidential));
- Testimonial Deposition Transcript of Applicant's marketing consultant, Marcus Jenkins, with exhibits (39 TTABVUE);
- Testimonial Deposition Transcript of Ruth Khalsa, Esq., who filed the Application on Applicant's behalf, with exhibits (39 TTABVUE);
- Testimonial Deposition Transcript of Applicant's distilled spirits consultant, Don Rodgers, with exhibits (47 TTABVUE);
- Opposer's first Notice of Reliance, with printouts from the USPTO database showing the status and title of its pleaded registrations (26 TTABVUE);
- Opposer's second Notice of Reliance, with discovery deposition transcript of Applicant's founder, Bryan Parks (27 TTABVUE, 28 TTABVUE (confidential));
- Opposer's third Notice of Reliance, with Applicant's responses to Opposer's discovery requests (29 TTABVUE);
- Opposer's fourth Notice of Reliance, with publications and court decisions re consumer recognition of Opposer's registered marks (30 TTABVUE);
- Opposer's fifth Notice of Reliance, with printouts from retailer websites and restaurant drink menus pertaining to the identified goods sold under Opposer's cited marks; a National Archive printout reflecting registration of Opposer's distillery as a National Historic Landmark; article re longevity and recognition of the MAKER'S MARK brand; dictionary definition of "MAKER"; webpages

reserving the right to raise additional affirmative defenses, is not itself an affirmative defense.

and advertisements re Opposer's goods bearing its cited brands (34 TTABVUE);

- Opposer's sixth Notice of Reliance, with printout from USPTO database re registration of MAKERS in connection with "whiskey," "whisky," or "bourbon"; dictionary definitions of "BOURBON" and "PRIVATE BRAND"; printouts from Internet websites re the use or nonuse of third-party marks cited by Applicant; webpages from Applicant's Facebook page and Twitter account. (48 TTABVUE).

Applicant introduced:

- Testimonial Declaration of Applicant's distilled spirits consultant, Don Rodgers (41 TTABVUE);
- Testimonial Declaration of Theodore Breiner, Esq. Applicant's counsel (44 TTABVUE);
- Applicant's first notice of reliance, with Opposer's responses to Applicant's discovery requests (36 TTABVUE);
- Applicant's second notice of reliance, with dictionary definitions of "BOWMAKERS" and "MAKER'S MARK"; printouts from the USPTO database showing status and title of third-party registrations and applications (37 TTABVUE);
- Applicant's third notice of reliance, with printouts from the USPTO database re status and title to a registration; printouts of websites, articles and results of Google searches (43 TTABVUE).

The parties have stipulated that Opposer's cited registered marks would have been among the 328 marks included in the results of the Examining Attorney's search criteria during examination of the subject Application (38 TTABVUE).

Evidentiary Objections

Opposer moves to strike the testimonial declaration of Applicant's counsel, Theodore Breiner and accompanying exhibits⁸ because Applicant failed to disclose

⁸ 44 TTABVUE.

him as a witness in its initial disclosures or pretrial disclosures.⁹

When testimony is presented by affidavit or declaration, but the witness was not identified in the party's pretrial disclosures, the remedy is the prompt filing of a motion to strike. Trademark Rules 2.121(e) and 2.123(e)(3)(i), 37 C.F.R. §§ 2.121(e) and 2.123(e)(3)(i). Such a prompt motion could allow Applicant to cure the alleged defect. *See Moke America, LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *4-5 (TTAB 2020); *Int'l Dairy Foods Ass'n v. Interprofession du Gruyère and Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, *3-4 (TTAB 2020) ("As a general rule, objections that are curable must be seasonably raised, or they will be deemed waived."). Opposer did not do so, so its motion to strike is waived or forfeited. *Philanthropist.com, Inc. v. The General Conference Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, Appendix B, *4 (TTAB 2021) appeal docketed (Fed. Cir. Aug. 5, 2021). We hasten to add that Applicant's subject evidence, though admitted, does not affect the outcome of this opposition proceeding; as the ensuing analysis establishes, we compare the parties' standard character marks based on their literal elements, not their trade dress, and we consider their goods based on their respective identifications, which do not include price points.

We also decline Opposer's invitation to strike exhibits 79 and 80 to Applicant's Third Notice of Reliance, which display Google search results for the terms "members mark bourbon" and "members mark whiskey prices." Opposer objects that Internet

⁹ Opposer's brief, Appendix A, 30 TTABVUE 55. The exhibits include: authenticated photographs showing Opposer's branded bourbon bottles, with prices, displayed on liquor store shelves; a copy of a drink menu showing the price of Opposer's MAKER'S MARK bourbon by the glass; Google search results pages for "Bowmaker's Whiskey"; and Applicant's website home page.

search summaries are not admissible by notice of reliance (citing *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546 (TTAB 2012) and the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.08(b)).¹⁰

The authorities on which Opposer relies stand for the generally accepted proposition that Internet hyperlinks and search engine results pages, without a copy of the corresponding web page, are insufficient to make information from the website of record. *See also Int'l. Dairy Foods v. Interprofession du Gruyère*, 2020 USPQ2d 10892, at *7-8; *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790 n.15 (TTAB 2018). But in exhibit 81, Applicant introduces a webpage offering “Member’s Mark Blended Scotch Whiskey” for sale.¹¹ And it introduces the two preceding exhibits, 79 and 80, to show that the third-party mark “Member’s Mark” is more similar to “Maker’s Mark” than its applied-for mark, as the search term “Member’s Mark” elicits references to “Maker’s Mark,” and Applicant’s mark does not. Opposer’s objections “go more to the weight rather than the admissibility of this evidence.” *Spiritline Cruises LLC v. Tour Mgmt. Svcs., Inc.*, 2020 USPQ2d 48324, *2, (TTAB 2020). The motion to strike is denied, and the evidence will be considered for what it is worth.

Applicant, for its part, objects to a survey purporting to show consumer recognition of Opposer’s marks. Opposer’s Senior Marketing Director, Nathalie Phillips, testifies that “In the regular course of its business, Maker’s Mark tracks ‘brand health’ by commissioning studies from outside firms such as Kantar Millward

¹⁰ Opposer’s brief, Appendix A, 30 TTABVUE 56.

¹¹ Applicant’s third Notice of Reliance, 43 TTABVUE 38-42.

Brown to determine consumers' awareness of its brands vis-à-vis its competitors. It has done so on an annual or quarterly basis since at least 2012. ... As Senior Marketing Director for Maker's Mark – International, and in my prior roles as Senior Brand Director for Maker's Mark – U.S. and Brand Director for Maker's Mark – U.S., I have overseen these market studies on behalf of the company.”¹² She attaches to her testimonial declaration a “Beam 2017 US Whiskey Report” “prepared by Kantar Millward Brown and sent to me by a representative of that firm upon its completion and saved in Maker's Mark's files at that time.”¹³ The report is based on interviews of 2,749 adult Americans between the ages of 22 and 59 who had consumed whisky in the month before being interviewed, and it purports to show, inter alia, that at least 69% of these consumers are aware of the brand MAKER'S MARK, and that MAKER'S MARK is consumed on premise (as opposed to at a consumer's home) approximately 40% of the time.¹⁴ The report, marked as Exhibit 1 to the Phillips declaration, is designated as confidential.¹⁵

Applicant reserved the right to object to the testimony of Ms. Phillips and the exhibits in her declaration to the extent the testimony lacks foundation and/or constitutes hearsay and/or otherwise violates a Federal Rule of Evidence.¹⁶ Applicant maintains this objection in its brief:

Applicant objects to the testimony in the Phillips declaration at paragraph 27 and the underlying Exhibit 1, the Kantar Millward Brown “Beam 2017

¹² Phillips decl. ¶¶ 19-20, 31 TTABVUE 7.

¹³ Phillips decl. ¶ 24, 31 TTABVUE 7.

¹⁴ Phillips decl. ¶ 27, 31 TTABVUE 8.

¹⁵ 32 TTABVUE 17-88.

¹⁶ Applicant's Reservation of Objections to Opposer's Testimony, 45 TTABVUE 2.

Whiskey Report March 2018” on the grounds that the Exhibit is hearsay; that is, the *alleged* percentages that 69% of consumers are aware of MAKER’S MARK and MAKER’S MARK is consumed on premise approximately 40% of the time is presented for the truth of the matter asserted. This is expert survey evidence without any underlying documentation, e.g. how the percentages were derived and who the respondents were, e.g. all U.S. citizens, U.S. citizens who are bourbon drinkers, etc. Applicant has not had the ability to cross-examine the survey expert providing these percentages and Opposer did not list any survey expert.¹⁷

Opposer responds that:

the full report, which included detailed information on the methodology and sample size and profile, was provided during discovery. As is evident in the opening slide, the study involved 2,749 respondents aged 22-59 who had consumed whiskey during the past month, 70% of whom were male and 30% of whom were female. Phillips Dec. Ex. 1. Applicant elected not to cross examine any of Opposer’s witnesses who offered this and other evidence as part of their testimony.¹⁸

The report was not introduced as an expert survey.¹⁹ It did not need to be in order to be admissible. The Board has considered brand awareness studies, commissioned in the ordinary course of business, as evidence of consumer recognition of marks. *See, e.g., Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2022 (TTAB (2014)(multiple consumers surveys commissioned by Chanel over the years; introduced via testimony of Chanel Division President of fashion, watches & fine Jewelry); *Nasdaq Stock Mkt., Inc. v. Antartica, S.r.l.*, 69 USPQ2d 1718, 1724 (TTAB 2003) (Nasdaq commissioned annual surveys to measure awareness of its stock market among the investing and general public; introduced via testimony of Nasdaq’s senior vice president of

¹⁷ Applicant’s brief, 51 TTABVUE 8-9.

¹⁸ Opposer’s reply brief, 52 TTABVUE 8 n.3.

¹⁹ *See* Fed. R. Evid. 702, made applicable to Board proceedings by Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a); TBMP § 702.02.

worldwide marketing and financial products).

The Federal Rules of Evidence provide an exception to the rule against hearsay for records of regularly conducted activity kept in the ordinary course of business. *See* Fed. R. Evid. 803(6). But when an organization relies on a document it has not prepared itself, “two factors bear on the admissibility of the evidence as a business record: ‘[1] that the incorporating business rely upon the accuracy of the document incorporated[,] and [2] that there are other circumstances indicating the trustworthiness of the document.’” *Christian Faith Fellowship Church v. Adidas AG*, 841 F.3d 986, 120 USPQ2d 1640, 1643 (Fed. Cir. 2016) *quoted in Int’l. Dairy Foods v. Interprofession du Gruyère*, 2020 USPQ2d 10892, at *6-7.

In this case, it is clear that Opposer Maker’s Mark relies on the accuracy of the Kantar Millward Brown report—the sort of report it periodically commissions in the ordinary course of business. In view of the report’s stated methodology—interviewing 2,749 respondents, with balanced representation, 70% male, 30% female, who had imbibed whiskey in the preceding month—it has some indicia of trustworthiness. The report’s finding that these respondents imbibed Opposer’s product on premise, i.e., in bars or restaurants, approximately 40% of the time is sufficiently trustworthy to be relied upon. The Board has frequently observed that alcoholic beverages are consumed in bars and restaurants, without relying on a study to state the obvious. *See, e.g., Schieffelin & Co. v. Molson Co’s.*, 9 USPQ2d 2069, 2073 (TTAB 1989) (“We also take into consideration the fact that the [alcoholic beverage] products of the parties are of the type ordered verbally in bars and restaurants.”).

But the Kantar Millward Brown report's other finding, that at least 69% of these whiskey consumers are aware of the brand MAKER'S MARK, lack some indicia of trustworthiness. Certain aspects of the report's methodology are unexplained, particularly: what questions the respondents were asked; whether the questions were clear and not leading;²⁰ whether the respondents were unaided, spontaneously mentioning Opposer's brands; or whether they were aided by being shown Opposer's marks and asked whether they were aware of the MAKER'S MARK brand;²¹ if so, whether they were shown the standard character marks at issue here, or bottles of Maker's Mark bourbon bearing its distinctive dripping red wax trade dress, which is not at issue; and what the respondents' verbatim answers were.²² The evidence of record does not elaborate on the survey's methodology with sufficient detail to address these concerns. *See Promark Brands v. GFA Brands*, 114 USPQ2d at 1246. And Applicant elected not to depose Ms. Phillips or a Kantar Millward Brown representative about the report's methodology, preferring instead to rely on its hearsay objection. *See generally* R.J. Leighton, "Using (and Not Using) the Hearsay Rules to Admit and Exclude Surveys in Lanham Act False Advertising and Trademark Cases," 92 Trademark Rptr. 1305 (2002).

²⁰ *See* 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 32:181 (5th ed. Sept. 2021 update) (factors to be considered in determining reliability of survey).

²¹ *Chanel, Inc. v. Makarczyk*, 110 USPQ2d at 2022 n. 10 ("Unaided' awareness indicates that the survey participant spontaneously mentions the CHANEL brand name without prompting; 'aided' awareness means that the survey participant responds 'yes' when asked whether he or she is aware of the CHANEL brand name."); *Promark Brands Inc. and H.J. Heinz Co. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1247 (TTAB 2015) ("In general, the Board has discouraged heavy reliance on aided awareness to prove fame....").

²² *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1510 (TTAB 2017).

In sum, the report has some indicia of trustworthiness, most notably its survey population, counterbalanced by the lack of information regarding the report's methodology. The Board can take these considerations into account:

[T]he Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations. . . . [W]e find no basis on which to strike any testimony or other evidence. As necessary and appropriate, we will point out any limitations in the evidence or otherwise note that the evidence cannot be relied upon in the manner sought. We have considered all of the testimony and evidence introduced into the record. In doing so, we have kept in mind the various objections raised by the parties and we have accorded whatever probative value the subject testimony and evidence merit.

Luxco, Inc. v. Consejo Regulador del Tequila, A.C., 121 USPQ2d 1477, 1479 (TTAB 2017). Applicant acknowledges this.²³

Accordingly, we need not strike the Kantar Millward Brown report; rather, we consider it for what it is worth, according diminished probative value to its brand awareness findings. In fact, we need not rely upon this survey evidence of brand awareness at all. *See Coca-Cola Co. v. Meenaxi Ent., Inc.*, 2021 USPQ2d 709, *50 n.169 (TTAB 2021) (“while a valid survey can be persuasive evidence, we have declined to find that one is necessary in a Board proceeding.”). The circumstantial evidence Opposer presents *infra* regarding its sales, advertising, and length of use of its subject marks, as recognized in unsolicited media coverage, evinces strong consumer recognition of its marks. Hence, the Kantar Millward Brown report is not outcome-determinative. *See Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, *3-4 (TTAB 2020).

²³ Applicant's brief, 51 TTABVUE 9.

Applicant further asserts that “Opposer’s witness declarations and a number of the underlying exhibits (e.g. Phillips Exhibit 2 and Wagner Exhibit 7) and Opposer’s Notice of Reliance Exhibits (e.g., Opp. NOR 4, Exhibits 13-20 and Opp. NOR 5, Exhibit 21) are objectionable, including on the grounds of hearsay.”²⁴

These materials consist mainly of unsolicited media articles relating to the claimed fame of Opposer’s marks—for example, “The 25 Most Important Bourbons Ever Made” Food & Wine,²⁵ or “These Are The 10 Best-Selling Bourbons, According to Drizly—and No. 1 is Shocking” Forbes.²⁶ In a similar case, where the opposer’s SWATCH mark was listed among the top one hundred brands, according to *Women’s Wear Daily*, the Board overruled the applicant’s objection to this unsolicited media mention on the bases of lack of foundation and hearsay:

Periodicals are considered self-authenticating pursuant to FED. R. EVID. 902(6) and may be admitted via notice of reliance pursuant to Section 2.122(e) of the Trademark Rules, 37 C.F.R. § 2.122(e). The article’s significance lies in showing on its face that opposer’s SWATCH mark is sufficiently well-known to be among the brands included. We therefore admit Exhibit 19 as a magazine article displaying evidence of the strength of the brand SWATCH (among many other such articles submitted by opposer), rather than as a scientific survey or other expert evidence.

Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co., 108 USPQ2d 1463, 1465-66 (TTAB 2013) *aff’d*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015).

So too here. Opposer’s unsolicited media mentions show that it is regarded as a well-known brand. This evidence will be considered accordingly, and Applicant’s objection is overruled.

²⁴ Applicant’s brief, 51 TTABVUE 9.

²⁵ FoodandWine.com 10/23/2020, Phillips decl. ex. 2, 31 TTABVUE 18-43.

²⁶ Forbes.com 7/23/2020, Wagner decl. ex. 7, 35 TTABVUE 103-106.

II. Opposer's Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action (formerly termed “standing”) is an essential element in every inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark when it demonstrates an interest falling within the zone of interests protected by the statute, and a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at * 6-7 (Fed. Cir. 2020), *cert. denied*, 141 S.Ct. 2671 (2021).

Opposer’s pleaded registrations, which the record shows to be valid, subsisting, and owned by Opposer, demonstrate that its interests fall within the zone of interests protected by statute. 15 U.S.C. §§ 1052(d), 1063. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *N.Y. Yankees P’ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015). Opposer’s reasonable belief in damage proximately caused by registration of the applied-for mark is established by its assertion of a likelihood of confusion claim that is not without merit. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“To establish a reasonable basis for a belief that one is damaged by the registration..., a [plaintiff] may assert a likelihood of confusion which is not wholly without merit....”). Applicant does not contest Opposer’s entitlement to bring and maintain this opposition.

III. Priority

Because Opposer's pleaded registrations are properly of record,²⁷ and there is no pending counterclaim for their cancellation, priority is not at issue in this opposition for the marks and goods identified therein. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Applicant accepts Opposer's priority of use.²⁸

IV. Likelihood of Confusion

Section 2(d) of the Trademark Act provides that an applied-for mark may be refused registration if it "[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive...." 15 U.S.C. § 1052(d).

To determine whether there is a likelihood of confusion between the marks under Section 2(d), we analyze the evidence and arguments under the *DuPont* factors. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*") cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). We consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). "Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances." *Stratus Networks, Inc.*

²⁷ Notice of Opposition, ex. B, 1 TTABVue 19-36.

²⁸ Applicant's brief, 51 TTABVue 18.

v. UBTA-UBET Commc'ns Inc., 955 F.3d 994, 2020 USPQ2d 10341, *3 (Fed. Cir. 2020). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services.” *Ricardo Media v. Inventive Software*, 2019 USPQ2d 311355 at *5 (TTAB 2019) (citing *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004)).

We focus particularly on Opposer's MAKER'S MARK and MAKER'S trademarks. If we find confusion likely between those pleaded marks and the applied-for mark, we need not consider likelihood of confusion with Opposer's other pleaded marks. On the other hand, if we find no likelihood of confusion, we would not find confusion likely between Applicant's mark and Opposer's other pleaded marks. *In re Max Capital Grp.*, 93 USPQ2d 1243, 1245 (TTAB 2010).²⁹

A. The Similarity of Goods and Channels of Trade

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration...,” and the third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

There is no dispute that the parties' identified goods are identical and legally identical. The Application identifies “distilled spirits, whiskey, bourbon.” Whiskey is

²⁹ Opposer pleaded that it owns a “family” of trademarks. Notice of Opposition ¶¶ 6, 33, 1 TTABVUE 6, 9. In its brief, however, Opposer only mentions its “family of Maker's Mark's products” in passing. 50 TTABVUE 23. In view of the disposition of Opposer's claim under Section 2(d) based on its registered marks, the Board need not reach this issue. *See Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) *quoted in Chutter, Inc. v. Great Mgmt. Grp. LLC*, 2021 USPQ2d 1001, *49-50 (TTAB 2021).

a kind of distilled spirit: to make whiskey, the distiller distills a fermented mash of grain, and then stores the distillate in oak containers.³⁰ Bourbon is a kind of whiskey made only in the United States:³¹ to make bourbon, the distiller distills a fermented mash of not less than 51 percent corn, and then stores the distillate in charred new oak containers.³²

Opposer specializes in making bourbon whiskey. *Maker's Mark Distillery, Inc. v. Diageo N. Am.*, 703 F.Supp. 671, 97 USPQ2d 1780, 1784 (W.D. Ken. 2010) (“Plaintiff Maker's Mark is a Kentucky-based distiller specializing in bourbon whisky.”). Opposer's pleaded registration for MAKER'S MARK identifies “whiskey.”³³ Its pleaded registration for MAKER'S identifies “alcoholic beverages except beers; whisky.”³⁴

Applicant accepts that the parties' goods are the same.³⁵

With no restrictions in the application and registration, these identical and legally identical goods are presumed to travel in the same channels of trade—primarily liquor stores, restaurants and bars—to the same class of consumers, in this case,

³⁰ 27 C.F.R. § 5.22(b).

³¹ 27 C.F.R. § 5.22(l) (“[T]he word ‘bourbon’ shall not be used to describe any whisky or whisky-based distilled spirits not produced in the United States.”). See *Maker's Mark Distillery, Inc. v. Diageo N. Am.*, 679 F.3d 410, 102 USPQ2d 1693, 1696 (6th Cir. 2012) (“In recognition of bourbon's unique place in American culture and commerce, ... Congress in 1964 designated bourbon as a ‘distinctive product[] of the United States,’ 27 C.F.R. § 5.22(l)(1), and prescribed restrictions on which distilled spirits may bear the label ‘bourbon.’”).

³² 27 C.F.R. § 5.22(b)(1)(i).

³³ Registration No. 0678192.

³⁴ Registration No. 4964096. Whiskey is sometimes spelled “whisky,” the preferred spelling in Scotland and Canada. *Maker's Mark Distillery v. Diageo*, 102 USPQ2d at 1695 n.1. See also “14 Things You Should Know About Maker's Mark Bourbon Whiskey” trypico.com/vinepair, 43 TTABVue 17.

³⁵ Applicant's brief, 51 TTABVue 18.

ordinary adult purchasers and consumers of whiskey. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) *cited in Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (identical goods). *See also In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *In re Bay State Brewing Co., Inc.*, 117 USPQ2d 1958, 1959-60 (TTAB 2016); *Syndicat Des Proprietaires Viticulteurs De Chateaufort-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1942 (TTAB 2013); *Schieffelin v. Molson*, 9 USPQ2d at 2073; *Monarch Wine Co., Inc. v. Hood River Dist., Inc.*, 196 USPQ 855, 857 (TTAB 1977) (whisky, vodka, rum, brandy, wine and champagne travel in same channels of trade). Applicant “does not dispute that the parties’ goods and channels of trade are the same.”³⁶

The second and third *DuPont* factors thus weigh heavily in favor of finding a likelihood of confusion.

B. The Strength of Opposer’s Mark

We now consider the strength of the cited registered mark. *DuPont*, 177 USPQ at 567.

Under Section 2(d), strength varies along a spectrum from very strong to very weak. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017). In determining the strength of a mark, we consider its inherent strength, based on the nature of the mark itself, and its

³⁶ *Id.* at 20.

commercial strength, based on its recognition in the marketplace. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength.”); *Bell’s Brewery v. Innovation Brewing*, 125 USPQ2d at 1345; MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. Sept. 2021 update) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”).

To determine the conceptual strength of Opposer’s marks, we evaluate where they lie “along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum....” *In re Davia*, 110 USPQ2d 1810, 1815 (TTAB 2014). A “Maker’s Mark” is “the hallmark on a piece of English gold, silver, or plate denoting the person or firm responsible for its production.”³⁷ As such, MAKER’S MARK is arbitrary, as it is a metalwork term randomly applied to bourbon. It is therefore conceptually strong. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (arbitrary terms are conceptually strong trademarks).

Opposer’s founder and his wife adopted the MAKER’S MARK trademark in the 1950’s, apparently as a reference to a circular design component:

³⁷ Merriam-Webster.com, Opposer’s second NOR, 37 TTABVue 13.

Softest Spoken of the Bourbons

Maker's Mark is Kentucky's softest spoken whisky. It glows with an old-style, hand-made flavor that's a country mile from regular factory-made whisky. It all started some years ago when Bill Samuels, a fourth generation distiller, left the mass liquor industry and restored a tiny steam-powered distillery on his farm near Loretto, Kentucky. Here he makes a whisky so uncommonly good that he proudly puts his personal mark  on every bottle. Look for the bottle with the red sealing wax on top. It looks expensive, and is. If you appreciate the uncommon, the gentle, genial taste of Maker's Mark was made for you.

* Mark of the Maker

LOUISVILLE

MARCH 20, 1964

KENTUCKY STRAIGHT BOURBON WHISKY • OLD STYLE SOUR MASH • NINETY PROOF • DISTILLED, BOTTLED AND BOTTLED BY STAR HILL DISTILLING COMPANY, STAR HILL FARM, LORETTO, KENTUCKY

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(In the circular design component, “S” stands for “Samuels,” the founder’s surname, “IV” for “fourth generation” of distillers, and the star for the Star Hill Farm in Loretto, Kentucky, home of the distillery.)³⁹ As we note below, MAKER’S is a shortened version of MAKER’S MARK, and derives its strength, both conceptually and commercially, from MAKER’S MARK.

The commercial strength or fame of a mark rests on the extent to which “a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator.” *Joseph Phelps Vineyards v. Fairmont Holdings*, 122 USPQ2d at 1734 (citing *Palm Bay v. Veuve Clicquot* 73 USPQ2d at 1694). It “may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of

³⁸ Wagner decl. ¶9, ex. 3, March 20, 1964 advertisement, 35 TTABVUE 95.

³⁹ WALL ST. J., Aug. 1, 1980, Opposer’s fourth NOR, ex. 14, 30 TTABVUE 29; Opposer’s first NOR ex. 1, 26 TTABVUE 137.

commercial awareness have been evident.” *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). Other relevant factors include “length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark.” *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012).

Opposer adduces the following evidence that MAKER’S MARK is commercially strong for bourbon whiskey, and entitled to a broad scope of protection:

- Maker’s Mark has been selling bourbon under the MAKER’S MARK trademark continually for over 60 years, since the 1950’s;⁴⁰
- The MAKER’S MARK trademark registered on May 5, 1959, and has subsisted on the Principal Register since then, becoming incontestable in 1964;⁴¹
- Maker’s Mark’s total net sales, according to the public Wagner declaration, number in the hundreds of millions of dollars annually; though the specific numbers are confidential, these sales figures are impressive by any measure, and have climbed steadily, over \$100 million, during the past four years;⁴²
- These sales figures make MAKER’S MARK a top-selling bourbon brand, cited as the second-best-selling bourbon on the Drizly.com e-commerce site, according to an April 2020 Forbes Magazine article;⁴³
- To boost sales and brand recognition, Maker’s mark expends tens of millions of dollars on advertising in the United States—a number that, though confidential, has doubled during the recent four years;⁴⁴

⁴⁰ Wagner decl. 6, 35 TTABVUE 5.

⁴¹ Opposer’s first NOR ex. 1, 26 TTABVUE 5-142.

⁴² Opposer’s brief, 50 TTABVUE 38; Wagner decl. ¶14, 35 TTABVUE 6.

⁴³ Wagner decl. ¶¶ 15, 18, 35 TTABVUE 6-7; Forbes.com 4/22/2020, Opposer’s fourth NOR ex. 19, 30 TTABVUE 46-47.

⁴⁴ Opposer’s brief, 50 TTABVUE 40, Phillips decl. ¶ 46, 31 TTABVUE 11.

- Each year, thousands of people travel to Loretto, Kentucky to visit Maker’s Mark Distillery on Star Hill Farm, where they can enjoy tours, tastings, and other events;⁴⁵
- As of October 21, 2020, the Facebook page affiliated with Maker’s Mark, www.facebook.com/makersmark, has over 839,000 likes and over 817,000 followers, and the Twitter account affiliated with Maker’s Mark, www.twitter.com/makersmark, has over 133,000 followers;⁴⁶
- Maker’s Mark has benefited from unsolicited third-party media coverage of the company and its products. *See Chutter v. Great Mgmt. Grp.*, 2021 USPQ2d 1001, at *30 (“Market strength may be measured indirectly by, inter alia, unsolicited media coverage”).
 - Most notably, Maker’s Mark garnered national attention in August 1980, when a front-page story in THE WALL STREET JOURNAL thrust the company into the national spotlight.⁴⁷
 - In 2015, 2016, and 2018, Maker’s Mark won the “Icons of Whisky Visitor Attraction of the Year” award from Whisky Magazine.⁴⁸
 - In November 2018, Food & Wine Magazine ranked MAKER’S MARK bourbon first among bourbons, the “clear choice for the top spot,” according to distillers, journalists, authors, and purveyors of whiskey.⁴⁹
 - In 2019, Maker’s Mark was awarded 1st Place in the “Best Bourbon Whiskey” category of the International Whiskey Competition.⁵⁰

⁴⁵ Wagner decl. ¶ 19, 35 TTABVUE 7.

⁴⁶ Phillips decl. ¶ 35, 31 TTABVUE 9.

⁴⁷ David P. Garino, Maker’s Mark Goes Against the Grain to Make its Mark, WALL ST. J., Aug. 1, 1980, at 1, *cited in Maker’s Mark Distillery, Inc. v. Diageo N. Am.*, 703 F.Supp. 671, 97 USPQ2d 1780, 1784 (W.D. Ken. 2010) and *Maker’s Mark Distillery, Inc. v. Diageo N. Am.*, 679 F.3d 410, 102 USPQ2d 1693, 1697 (6th Cir. 2012); Wagner decl. ¶ 8, 35 TTABVUE 5, 70-72.

⁴⁸ Phillips decl. ¶¶ 31-32, 31 TTABVUE 9.

⁴⁹ FoodandWine.com/cocktailsspirits/25-most-important-bourbons-ever-made, Phillips decl. ¶ 29, 31 TTABVUE 8 and ex. 2.

⁵⁰ Whiskycompetition.com/2019-results, Phillips decl. ¶ 31, 31 TTABVUE 9.

- On March 2, 2020, Esquire Magazine included MAKER'S MARK bourbon on its profile of "The 10 Best Bourbon Whiskey Brands to Drink Right Now".⁵¹
- Opposer's Senior Marketing Director concludes: "Based on these accolades and awards, and based on my personal knowledge of the industry after working on behalf of both Maker's Mark and a number of its competitors since 2004, it would be no exaggeration to say that MAKER'S MARK is among the most well recognized – if not the most well recognized – bourbon brand in the United States."⁵²

Even though this last pronouncement is self-interested, as it is rendered on behalf of one party, the other party, Applicant, acknowledges that "the MAKER'S MARK trademark is well-known."⁵³ Applicant's distilled spirits consultant, Don Rodgers, who spent 34 years working at Beam Global Spirits and Wine, which produces MAKER'S MARK bourbon, testified that "Everybody knows Maker's Mark."⁵⁴ He further stated:

A. It's a well-known brand.

Q. I mean, would you call it a famous brand?

A. Yes.⁵⁵

Even Applicant's founder, Bryan Parks, acknowledged MAKER'S MARK'S reputation:

Q. And Maker's Mark is one of the best-known brands of bourbon in the United States; isn't that

⁵¹ Esquire.com/food-drink/drinks/a26802724/best-bourbon-whiskey-brands/, Phillips decl. ¶ 30, 31 TTABVUE 8.

⁵² Phillips decl. ¶ 33, 31 TTABVUE 9.

⁵³ Applicant's brief, 51 TTABVUE 18.

⁵⁴ Rodgers dep. 18:14, 47 TTABVUE 22.

⁵⁵ Rodgers dep. 44:19-22, 47 TTABVUE 47.

right?

A. Purportedly so.⁵⁶

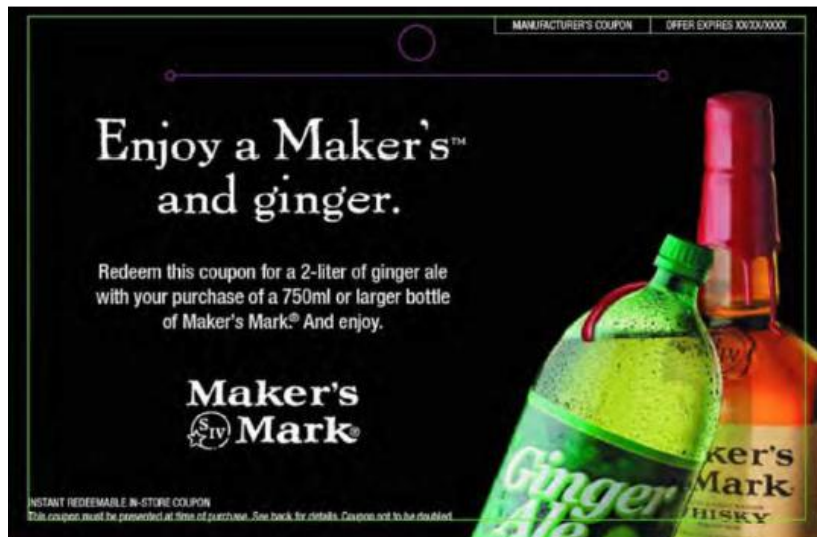
This evidence of extensive public recognition attaches to its shorthand form, MAKER'S for bourbon. Opposer's Vice President of Finance declares:

When consumers go to a bar or restaurant and want to select a MAKER'S MARK bourbon, they frequently ask for MAKER'S. Similar to a consumer asking for BUD as shorthand for BUDWEISER beer, using the term MAKER'S has become a quick, easy, and more casual way of referring to the brand. This is known in the industry as the "bar call," and it is an important part of how our trademarks are used by consumers.⁵⁷

He further avers that MAKER'S has been popularized in advertising as a standalone mark⁵⁸:

Maker's Mark has also used the term MAKER'S standing alone in its advertising for bourbon. For example, Maker's Mark launched an advertising campaign called "THE BOLD SIDE OF MAKER'S" and another campaign called "ENJOY A MAKER'S AND GINGER."⁵⁹

For example:

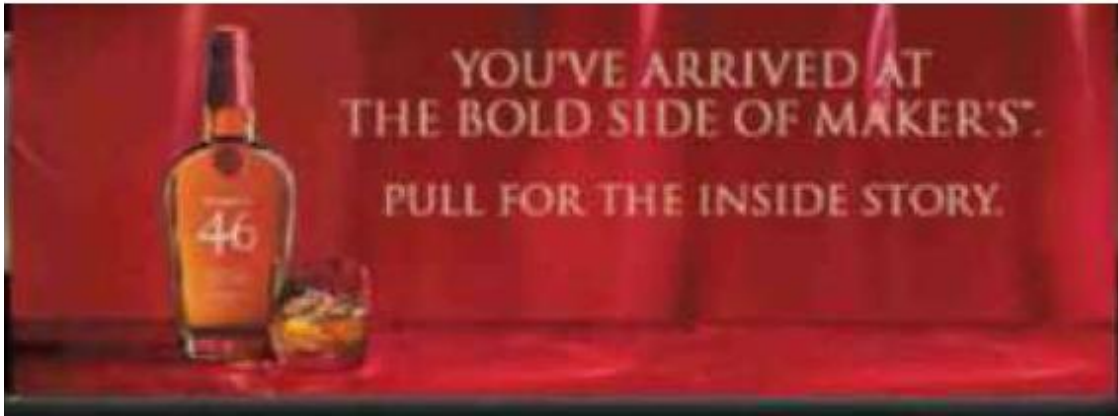


⁵⁶ Parks dep. 51:19-22, 39 TTABVUE 51.

⁵⁷ Wagner decl. ¶ 10, 35 TTABVUE 5.

⁵⁸ As noted, MAKER'S is also a registered mark, Reg. No. 4964096, claiming first use in commerce as of November 1, 1957.

⁵⁹ Wagner decl. ¶ 12, 35 TTABVUE 6.



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Applicant's witnesses apparently agree. Don Rodgers, Applicant's distilled spirits consultant, was asked:

Q. What do you think are the leading
bourbon brands in the United States?

A. What do I think the leading?

Q. Yeah. Yeah.

A. Of course, Beam, Knobb Creek, Jack
Daniels, **Maker's**. Those are the biggies.

Q. Got it.

**And when you say Maker's, you mean
Maker's Mark?**

A. Yes, Maker's Mark.

Q. Maker's is a nickname for Maker's Mark?

A. Like Jim is a nickname for Jim Beam.

Yeah.⁶¹

Q. If I showed up at a bar in Frankfort,
Kentucky, and asked for a Maker's, what would
they give me?

⁶⁰ Opposer's brief, 50 TTABVUE. 25-26; Wagner decl. ¶¶ 13 and ex. 4-5, 35 TTABVUE 6, 97, 101.

⁶¹ Rodgers dep. 41:11-23, 47 TTABVUE 45 (emphasis added).

A. Maker's Mark.⁶²

Applicant's founder, Bryan Parks, testified that if a customer ordered a "Maker's" at a bar, the bartender would probably ask what variety of MAKER'S MARK the customer wanted:

Q. What clarification do you think they'd ask for if I asked for a Maker's on the rocks at a bar?

A. There -- it would depend on what varieties of Maker's Mark they carry on the shelf.⁶³

In view of all the evidence, we find Opposer's MAKER'S MARK and its shorthand "bar call," MAKER'S, are extremely well-known among consumers of whiskey, particularly bourbon whiskey. *See Palm Bay v. Veuve Clicquot* 73 USPQ2d at 1694 ("Fame for confusion purposes arises as long as a significant portion of the relevant consuming public, namely, purchasers of champagne and sparkling wine, recognizes the mark as a source indicator."). Indeed, it is fair to say that the marks can be considered famous.

"All courts agree that 'stronger' marks are given 'stronger' protection—protection over a wider range of related products and services and variations on visual and aural format." 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:73 (5th ed. Sept. 2021). As the Federal Circuit has put it, more emphatically: "The fifth *DuPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection" and "cast[] a long shadow which competitors must avoid." *Kenner Parker Toys Inc. v. Rose*

⁶² Rodgers dep. 41:24-42:2, 47 TTABVUE 45-46.

⁶³ Parks dep. 53:9-15, 39 TTABVUE 57.

Art Indus. Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862, 113 S.Ct. 181 (1992) *quoted in Bridgestone Am. Tire Ops. LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1063 (Fed. Cir. 2012).

Thus, Opposer's marks are conceptually arbitrary and commercially famous for whiskey, particularly bourbon whiskey. This factor thus plays a dominant role in determining likelihood of confusion.

Applicant argues that MAKER'S MARK and MAKER'S are not strong trademarks, introducing evidence of about three dozen third-party registrations or applications for what it terms "similar or related goods."⁶⁴ It argues that "[e]vidence of use of similar marks by third parties for similar or related goods is relevant to a mark's commercial strength and the scope of protection to be accorded the asserted trademark(s)."⁶⁵

Applicant's evidence consists solely of third-party registrations and applications. "[C]itation of third-party registrations as evidence of market weakness is unavailing because third-party registrations standing alone, are not evidence that the registered marks are in use on a commercial scale, let alone that consumers have become so accustomed to seeing them in the marketplace that they have learned to distinguish among them by minor differences." *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016). "We have frequently said that little weight is to be given such [third party] registrations in evaluating whether there is likelihood of

⁶⁴ Applicant's brief, 51 TTABVUE 22-24, Applicant's second NOR, exs. 36-74, 37 TTABVUE 15-86.




⁶⁵ Applicant's brief, 51 TTABVUE 24 (citing *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1346 (TTAB 2017)).

confusion. The ‘existence of [third-party] registrations is not evidence of what happens in the market place or that customers are familiar with them....’” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) *quoted in part in In re Inn at St. John’s*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d* 777 Fed. Appx. 516 (Fed. Cir. 2019). Applicant’s evidence of third-party registrations and applications thus fails to diminish the commercial strength of Opposer’s famous marks.

However, third-party registrations are relevant evidence of the inherent or conceptual strength of a mark or term because they indicate how terms are used in connection with the goods or services identified in the registrations. *In re Morinaga*, 120 USPQ2d at 1745-46. Even where the record lacks proof of actual third-party use, third-party registration evidence may show that a term carries a descriptive or highly suggestive connotation in the relevant industry and therefore may be considered conceptually weak. *Institut National Des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992).

But Applicant’s evidence falls short of showing conceptual weakness. Opposer charts the status of Applicant’s proffered third-party registrations and applications in the following table copied below:

TRADEMARK	REG. NO.	GOODS (SUMMARY)	STATUS
MAKER’S MARK	1,693,478	Marketing consulting services	DEAD
MAKER’S MARK	1,040,945	Dinnerware and related service pieces	DEAD
MAKER’S MARK	795,289	Men’s and Boy’s outer garments	DEAD

TRADEMARK	REG. NO.	GOODS (SUMMARY)	STATUS
MAKER'S MARK	87/746,837 (never registered)	Men's skincare, grooming and beauty products	DEAD
MAKER'S TABLE	3,114,487	Alcoholic beverages, namely, wines	DEAD
MAKER'S TABLE	86/736,259 (never registered)	Wines	DEAD
THE MAKER	4,403,990	Wines	LIVE
BARREL MAKER	4,790,239	Wine	LIVE
MAP MAKER	3,653,684	Wine	LIVE
MAGIC MAKER	4,460,225	Wine	LIVE
SIN MAKER	4,049,639	Alcoholic energy drinks	LIVE
	4,053,946	Alcoholic energy drinks	LIVE
 STRIKE MAKER	5,308,828	Alcoholic beverages	LIVE
THE PARTY MAKER	3,651,463	Alcoholic beverages	DEAD
MAGICK MAKER	85/852,405 (never registered)	Wine	DEAD
BABY MAKER	88/278,457	Wine	LIVE
THE BABY MAKER	86/397,072 (never registered)	Wine	DEAD
BLACK MAKER	88/205,021 (never registered)	Alcoholic beverages	DEAD
MISCHIEF MAKER	86/736,259 (never registered)	Wines	DEAD
MATE MAKER BEVERAGES	88/914,627 (never registered)	Beers	LIVE
MEMBER'S MARK	3,941,793	Alcoholic beverages	LIVE
MEMBER'S MARK	5,396,943	Alcoholic beverages	LIVE
COOPER'S MARK	4,115,536	Distilled Spirits	LIVE
OLD MARK	4,739,555	Vodka	LIVE
 OLD MARK	4,739,553	Vodka	LIVE
GREEN MARK	3,744,765	Vodka	LIVE
SILVER MARK	4,429,720	Alcoholic beverages	DEAD
SHEPHERDS MARK	4,083,804	Wines	LIVE
VINTNER'S MARK	4,238,105	Wines	LIVE
BEAUTY MARK	5,222,540	Wines	LIVE
ROYAL MARK	1,285,527	Whiskey	DEAD
KING'S MARK	842,977	Whiskey	DEAD
FANCY MARK	600,119	Gin	DEAD
EIGHTH MAKER	6,086,233	Wine	LIVE
WINE MAKER'S ESSENTIALS	5,044,213	Wine making equipment kits	LIVE

TRADEMARK	REG. NO.	GOODS (SUMMARY)	STATUS
MEMBER'S MARK	5,396,942	Cocktail mixes	LIVE
MEMBERS MARK	2,582,569	Malt beer Fruit Juices	LIVE
MARK MAKER	1,635,458	Marking products and equipment	LIVE

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Approximately half are applications or dead registrations. Applications “are evidence only that the applications were filed on a certain date . . . ,” and “‘dead’ or cancelled registrations have no probative value at all.” *In re Embiid*, 2021 USPQ2d 577, *35-36 & n. 28 (TTAB 2021). *See also In re Sibony*, 2021 USPQ2d 1036, *8 (TTAB 2021) (third-party applications are evidence only of the fact that they have been filed, and have no other probative value.).

Of the remaining live registrations, ten contain the word “MARK”; but that word is already disclaimed as descriptive in Opposer’s MAKER’S MARK registration, so this accomplishes nothing more than to show that MAKER’S is the dominant, distinctive component in MAKER’S MARK. *See Chutter v. Great Mgmt. Grp.*, 2021 USPQ2d 1001, at *36 (disclaimed matter less significant in creating mark’s commercial impression).⁶⁷ And it is the sole word comprising the MAKER’S trademark.

Eleven of the remaining live registrations contain the word “MAKER” or “MAKERS,” but they identify such disparate goods as alcoholic energy drinks, wine, wine making equipment kits, and in one registration, “marking products and

⁶⁶ Opposer’s reply brief, 52 TTABVUE 15-17. The Board has reviewed the contents of the table, and confirms its accuracy, save for an entry in the sixth row, 85/807,684, which had an inaccurate Application Serial Number (86/736,259); nonetheless, Application Serial No. 85/807,684 has been abandoned, as the table accurately indicates.

⁶⁷ For this reason, Applicant’s reference to the similarity between the third-party mark MEMBER’S MARK and MAKER’S MARK carries little probative value.

equipment.” See *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693-95 (Fed. Cir. 2018) (error to rely on third-party evidence of similar marks for dissimilar goods); *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017) (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained their similarity to the goods in the cited registration). Although wine and whiskey are both alcoholic beverages, Applicant’s identified goods are “distilled spirits; whiskey; bourbon” and Opposer’s marks are famous for whiskey, particularly bourbon whiskey. Moreover, Opposer’s witnesses have declared that they are not aware of any company besides Maker’s Mark that currently offers bourbon whiskey for sale in the United States using the term “MAKER” or “MAKER’S” in its name.⁶⁸ So these third-party registrations do not lessen the conceptual strength of Opposer’s marks for whiskey.



**STRIKE
MAKER**

That leaves one third-party registration for “alcoholic beverages except beers.” This is broad enough to encompass whiskey, but evidence of one third-party registration of a similar mark is not sufficient to establish that Opposer’s mark is weak and entitled to only a narrow scope of protection. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058-59 (TTAB 2017).

⁶⁸ Phillips decl. ¶ 60, 31 TTABVUE 14. Wagner decl. ¶ 26, 35 TTABVUE 8. Opposer’s brief, 50 TTABVUE 23.

In short, Applicant's third-party registration and application evidence does not diminish the conceptual or commercial strength of Opposer's arbitrary and famous marks.

C. The Similarity of the Parties' Marks

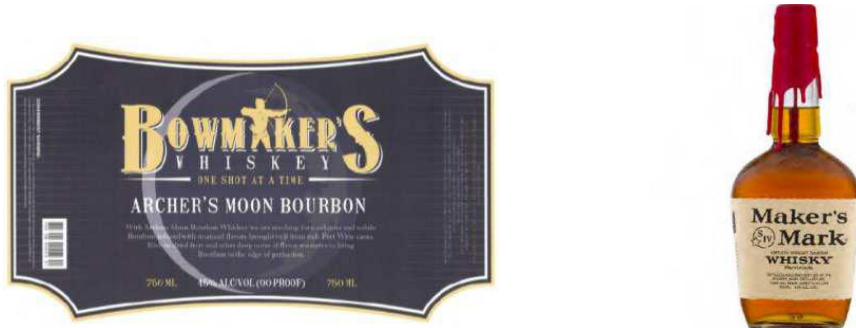
Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's and Opposer's marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1160; *Palm Bay v. Veuve Clicquot* 73 USPQ2d at 1692. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's*, 126 USPQ2d at 1746 (citing *In re Davia*, 110 USPQ2d at 1812).

Once again, the respective marks are MAKER'S MARK (with "MARK" disclaimed), MAKER'S, and BOWMAKER'S WHISKEY (with "WHISKEY" disclaimed). Applicant argues that:

The BOWMAKER'S WHISKEY trademark is completely different from the MAKER'S MARK trademarks in pronunciation, appearance, spelling and meaning. The BOWMAKER'S WHISKEY trademark connotes a person who makes bows. The dictionary definition of MAKER'S MARK is the hallmark on a piece of English gold, silver or plate denoting the person responsible for its production. These meanings are completely different. As such the commercial impression of the parties' respective marks is completely different establishing no likelihood of confusion. This position is supported by the Examining Attorney's allowance of the BOWMAKER'S WHISKEY trademark; the trademark clearance opinion of LegalForce; the testimony of Ms. Khalsa, a trademark attorney; and Mr. Rodgers, a person with more than 40 years experience in the distilled spirits business, including at Jim Beam, the owner of Maker's Mark.⁶⁹

⁶⁹ Applicant's brief, 51 TTABVUE 26. *See also* 51 TTABVUE 5, 10-12, 19-20,

Applicant continues, stating: “A side-by-side comparison of the BOWMAKER’S WHISKEY label and the MARKER’S MARK label are as follows”:



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We find, though, that Applicant’s arguments run up against several established principles that render the marks more similar than dissimilar. First, “where . . . the goods at issue are identical, the degree of similarity necessary to support a conclusion of likely confusion declines.” *In re Viterra*, 101 USPQ2d at 1908, *cited in Zheng Cai v. Diamond Hong*, 127 USPQ2d at 1801. Second, “the Lanham Act’s tolerance for similarity between competing marks varies inversely with the fame of the prior mark.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) (quoting *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (“As a mark’s fame increases, the Act’s tolerance for similarities in competing marks falls.”). “Furthermore, it is well recognized that the law today rewards a famous or well-known mark with a larger cloak of protection than in the case of a lesser known mark because of the tendency of the consuming public to associate a relatively unknown mark with one to which they have long been exposed if the mark bears any

⁷⁰ Applicant’s brief, 51 TTABVue 16.

resemblance thereto.” *R. J. Reynolds Tobacco Co. v. R. Seeling & Hille*, 201 USPQ 856, 860 (TTAB 1978).

“[T]here is ... no excuse for even approaching the well-known mark of a competitor.” *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1285 (Fed. Cir. 1984) *quoted in In re Mr. Recipe, LLC*, 118 USPQ2d 1084 (TTAB 2016). In this case, Applicant’s founder was well aware of the fame of MAKER’S MARK, as well as its shortened “bar call” variant, MAKER’S. Yet he not only approached the mark, but adopted its most dominant part: MAKER’S—the first and most distinctive part of MAKER’S MARK. *See Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered”) *quoted in In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181 (TTAB 2018). The disclaimed second word MARK “is less significant in creating the mark’s commercial impression.” *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) *quoted in Chutter v. Great Mgmt. Grp.*, 2021 USPQ2d 1001, at *36.

Applicant attempts to reduce MAKER’S MARK to its original dictionary meaning of a craftsman’s imprint, but that is unavailing:

The fact that a word or term may be found in a dictionary does not indicate that the word is lacking in trademark significance unless the dictionary meaning of the word is descriptive of the goods in connection with which it is used. That is, the capability of a dictionary word to function as a trademark must be determined by the simple expedient of exploring what meaning, if any, does it possess as applied to a particular product. In this regard, it must be recognized that while a word may have a meaning or descriptive significance as applied to one product, it may not have such a significance as applied to a different product.

Alberto-Culver Co. v. Helene Curtis Indus., Inc., 167 USPQ 365, 370 (TTAB 1970). “Maker’s mark” may have originated as a craftsman’s imprint as applied to pewter, but it is now renowned as Opposer’s mark as applied to bourbon whiskey.

Applicant’s side-by-side comparison of the parties’ labels is similarly unavailing. The parties’ marks are standard character marks, which may be used in “any particular font style, size, or color,” Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a), including stylized letters that resemble one another. *In re Vitterra.*, 101 USPQ2d at 1909-11; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (“[b]y presenting its mark merely in a typed drawing, a difference cannot legally be asserted by that party”). And “[t]he marks ‘must be considered ... in light of the fallibility of memory’ and ‘not on the basis of side-by-side comparison.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)). “Regardless, we do not consider how Applicant and Registrant actually use their marks in the marketplace, but rather how they appear in the registration and the application.” *In re Aquitaine Wine*, 126 USPQ2d at 1186.

This undercuts the opinion expressed by Applicant’s distilled spirits consultant, Don Rodgers, that the parties’ marks were dissimilar, as he based that opinion on the differing trade dress:

A. ... Maker’s Mark is very unique in the red wax. Everyone knows that. I mean, it’s a well-known brand, there’s no doubting it. If not, it’s right there with Jim Beam and Jack Daniels.

And Bowmaker's, that's why I wanted to see the label. I mean, there's no red wax -- there's no wax on this -- I don't even think he has a bottle yet. He just has a label, and it looks nothing like a Maker's Mark label.⁷¹

The trademark attorney who filed Applicant's subject application also opined in her testimony that the applied-for mark differed from Opposer's,⁷² but that amounts to little more than attorney argument. *In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298, *3 (TTAB 2020) (attorney argument no substitute for evidence). One could hardly expect a party's attorney to opine differently.

The parties have stipulated that Opposer's cited registered marks would have been among the 328 marks included in the results of the Examining Attorney's search criteria during examination of the subject Application.⁷³ But the prior implicit finding of the Examining Attorney in the ex parte prosecution of Applicant's application is not binding on this Board in a subsequent adversary proceeding. *See, e.g., Super Bakery Inc. v. Benedict*, 96 USPQ2d 1134, 1135 n.1 (TTAB 2010); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres Inc.*, 56 USPQ2d 1538, 1541 (TTAB 2000). Nor should it be, as the Examining Attorney was not privy to the wealth of evidence Opposer has introduced regarding the strength of its marks. *In re Mr. Recipe*, 118 USPQ2d at 1086 ("Because of the nature of the evidence required to

⁷¹ Rodgers dep. 55:9-18, 47 TTABVUE 59. Mr. Rodgers further asserted that others in the industry did not perceive any confusing similarity between the parties' marks. Rodgers dep. 51:11-52:9, 47 TTABVUE 55-56. This assertion is both hearsay and legally conclusory, and is given no consideration.

⁷² Khalsa dep. 89:1-6, 39 TTABVUE 258.

⁷³ 38 TTABVUE.

establish the fame of a registered mark, the Board does not expect Trademark Examining Attorneys to submit evidence as to the fame of the cited mark in an ex parte proceeding, and they do not usually do so.”).

Applicant relies on *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ 2d 1459 (Fed. Cir.1998), in which the Federal Circuit, in a per curiam decision, affirmed the Board’s finding that the trademarks CRISTAL and CRYSTAL CREEK were so dissimilar that there was no likelihood of confusion between the two, even though the goods were legally identical (champagne versus wine), were presumed to have the same channels of trade and classes of customers, and the opposer’s mark, CRISTAL, had a very strong indication of origin. *Id.* at 1460. Here, as there, Applicant contends that the dissimilarity of the marks is the dispositive *DuPont* factor.⁷⁴

Applicant’s reliance on *Champagne Louis Roederer* is misplaced. There, the Board found that the second word in applicant’s mark CRYSTAL CREEK served to create a totally different commercial impression from the one created by opposer’s mark, CRISTAL. As the Federal Circuit recounted:

[T]he Board found that the word marks “CRISTAL” and “CRYSTAL CREEK” evoked very different images in the minds of relevant consumers: while the former suggested the clarity of the wine within the bottle or the glass of which the bottle itself was made, the latter suggested “a very clear (and hence probably remote from civilization) creek or stream.”
Id.

In this case, by contrast, Applicant disclaims the second word in its mark, WHISKEY, as it is obviously generic for “whiskey.” *See In re Chatam Int’l Inc.*, 380

⁷⁴ Applicant’s brief, 51 TTABVUE 5, 20, 25.

F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (“As a generic term, ALE simply delineates a class of goods.”). “Whiskey” (or “whisky”) is identified in the Application and Opposer’s registered marks, so Applicant’s addition of “WHISKEY” in its mark simply emphasizes the parties’ identical goods.

Other differences further distinguish this case from *Champagne Louis Roederer*. The Federal Circuit majority observed that “the opposition proceeding, and thus the record, was characterized by a lack of evidence on many of the *DuPont* factors....” *Champagne Louis Roederer*, 47 USPQ2d at 1460. Judge Michel, concurring, further noted that the Board’s analysis did not explain how it weighed the dissimilarity of the marks against the similarity in the goods, channels of trade, and classes of customers, as well as the strength of the opposer’s mark. *Id.* at 1461-62, 1464 (Michel, concurring). For example, it did not explain its departure from “previous Board decisions holding that the degree of similarity between competing marks, where the goods on which the marks are used are directly competitive, need not be as great before registration should be denied.” *Id.* at 1463. Nonetheless, the majority and concurring opinions agreed that the opposer, Roederer, which bore the burden of proof before the Board and of persuasion on appeal, failed to demonstrate clear error in the Board’s factual findings, so the Court declined to disturb the Board’s decision dismissing Roederer’s opposition. *Id.* at 1461, 1464-65.

Here, unlike *Champagne Louis Roederer*, Opposer has presented voluminous evidence supporting its claim of likelihood of confusion under the *DuPont* factors. Far from contesting this evidence, Applicant has admitted that the parties’ goods are the same, and that they travel through the same channels of trade to the same classes of

relevant consumers.⁷⁵ We have noted that in view of the identity of the goods, the degree of similarity necessary to support a conclusion of likely confusion declines. *In re Viterra*, 101 USPQ2d at 1908. And we have noted that the strength of Opposer's marks, unattenuated by Applicant's third-party registration evidence, further reduces the degree of similarity needed to reach that conclusion. *Century 21 v. Century Life*, 23 USPQ2d at 1701.

"All courts agree that 'stronger' marks are given 'stronger' protection—protection over a wider range of related products and services and **variations on visual and aural format.**" *See* 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:73 (5th ed. Sept. 2021 update) (emphasis added). In this case, as Applicant's founder conceded, if a customer ordered a "MAKER'S" at a bar, the bartender would probably ask what variety of MAKER'S MARK the customer wanted.⁷⁶ Opposer does indeed have different varieties from MAKER'S MARK PRIVATE SELECT to MAKER'S 46 to MAKER'S MARK CASK STRENGTH:



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⁷⁵ Applicant's brief, 51 TTABVUE 20.

⁷⁶ Parks dep. 10/22/2020, 52:24-53:15; 39 TTABVUE 56-57.

⁷⁷ Opposer's brief, 50 TTABVUE 18.

Consumers familiar with Opposer's bourbon whiskey would be likely to believe, upon encountering bourbon whiskey offered under Applicant's mark, that it is a variation or line extension of Opposer's products. *See Joel Gott Wines LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1433 (TTAB 2013) ("Purchasers of opposer's GOTT and JOEL GOTT wines are likely to assume that applicant's goods, sold under the mark GOTT LIGHT and design, are merely a line extension of goods emanating from opposer"); *Schieffelin v. Molson*, 9 USPQ2d at 2073 ("Those consumers who do recognize the differences in the marks may believe that applicant's mark is a variation of opposer's mark that opposer has adopted for use on a different product.").

Given that the applied-for mark incorporates MAKER'S, the dominant, distinctive, or only term comprising Opposer's marks, both parties' brands connote that this is the "MAKER'S" whiskey. Applicant's addition of the prefix BOW to MAKER'S does not suffice to dispel confusion between the two marks. *See Stone Lion Capital*, 110 USPQ2d at 1161 (STONE LION CAPITAL incorporated the entirety of the registered marks LION CAPITAL and LION). If the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences. *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985).

On the whole, there are some differences between the parties' marks when viewed side-by-side, but that is not the standard. Taken in their entirety, and encountered in the marketplace, as they would be, they are more similar in sound and commercial impression than they are dissimilar.

D. Consumer Sophistication and Care

The fourth *DuPont* factor is “the conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567.

Applicant argues that “The parties’ goods are expensive and purchased by ... discriminating and sophisticated customers exercising a substantial degree of care.”⁷⁸ Applicant’s founder testifies that “I’m going to target the 37 to \$39 range” for each bottle of whiskey.⁷⁹ Applicant further notes that Opposer’s whiskey sells in the range of \$16.00 to \$75.00 per bottle, and \$12.00 to \$16.00 per glass in restaurants and bars.⁸⁰ Opposer has even advertised its bourbon under the slogan “IT TASTES EXPENSIVE...AND IS.”⁸¹

While many bourbon drinkers have discriminating tastes, Opposer concedes, they cannot exercise great care when ordering their drinks orally at bars and restaurants, where they call for drinks by brand name, often in noisy environments: “Opposer presented un rebutted testimony that consumers commonly abbreviate the MAKER’S MARK trademark into the “bar call” MAKER’S, itself a registered trademark that is well recognized by consumers. ... When taking an order in a loud bar, one could easily miss the first syllable of ‘BOWMAKER’S’ and hear ‘MAKER’S’ instead, particularly when the latter stands for a renowned bourbon brand that is so versatile that one

⁷⁸ Applicant’s brief, 51 TTABVUE 21.

⁷⁹ Parks dep. 89:3, 39 TTABVUE 93.

⁸⁰ Breiner decl. ¶ 2, exs. 87-95, 44 TTABVUE 2-12; “Bourbon guide 101” drizly.com/bourbon-guide, 43 TTABVUE 29-30; Rodgers decl. ¶ 10, 41 TTABVUE 4.

⁸¹ See “14 Things You Should Know About Maker’s Mark Bourbon Whiskey” trypico.com/vinepair, 43 TTABVUE 19 (1966 ad campaign).

industry executive observed you ‘can’t run a bar without’ it.”⁸² As for pricing, Opposer points to websites from alcoholic beverage retailers offering its bourbon from about \$28.00 to \$40.00 per bottle, and restaurant drink menus listing its bourbon at \$5.50 to \$10.00 per glass.⁸³

In the final analysis, we must look to the identification of goods in the Application and Registrations, none of which set price points or restrict their customers to careful sophisticates. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 765 (TTAB 1986) (“evidence and/or argument relating to the fact that the particular wines sold under the marks are expensive, high quality wines sold in high-quality wine and spirits stores to discriminating, sophisticated purchasers who would likely be familiar with the vineyard naming customs in France must be disregarded since there is no restriction in the application or registration limiting the goods to particular channels of trade or classes of customers.”).

Absent such restrictions, there is no reason to infer that the parties’ customers will be particularly sophisticated, discriminating, or careful in making their purchases. *See Somerset Distilling Inc. v. Speymalt Whisky Dist. Ltd.*, 14 USPQ2d 1539, 1542 (TTAB 1989) (while certain purchasers may be aficionados of certain brands, others may not be as knowledgeable, and may purchase distilled spirits as gifts, or to stock a bar for their guests). The parties’ bourbons may be offered to a range of customers, both sophisticated and unsophisticated, and we must base our

⁸² Opposer’s reply brief, 52 TTABVUE 13.

⁸³ Drizly.com, Binny’s Beverage Depot, Binnys.com, Brother John’s Beer, Bourbon and BBQ restaurant in Tucson, Arizona, BrotherJohnsBBQ.com, and Tony’s on Main Street in St. Charles, Missouri, TonysOnMain.com, Opposer’s fifth NOR, exs. 21-24, 34 TTABVUE 7-64.

decision on the least sophisticated potential customers. *In re Bay State Brewing Co., Inc.*, 117 USPQ2d 1958, 1960 n. 4 (TTAB 2016) (citing *Stone Lion v. Lion Capital*, 110 USPQ2d at 1163 (recognizing Board precedent requiring consideration of the “least sophisticated consumer in the class”)). The conditions of sale—particularly bars—may exacerbate the likelihood of confusion, but the sophistication and care of the relevant consumers do not mitigate it.

The fourth *DuPont* factor is therefore neutral.

E. Any Other Established Fact

The thirteenth *DuPont* factor is “[a]ny other established fact probative of the effect of use.” *DuPont*, 177 USPQ at 567. This “catch-all” factor includes bad faith on the part of applicants. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1442 (TTAB 2012) (“...bad faith is strong evidence that confusion is likely, as such an inference is drawn from the imitator’s expectation of confusion.”). This especially holds true for applicants who purposely creep close to established, famous marks under the guise of minimal distinguishing characteristics. “It has been well said that the most successful form of copying is to employ enough points of similarity to confuse the public with enough points of differences to confuse the courts.” *Philip Morris, Inc. v. Rothmans of Pall Mall, Ltd.*, 180 USPQ 592, 601 (TTAB 1973) (quoting *Baker et al. v. Master Printers Union of New Jersey*, 47 USPQ 69, 72 (D. NJ, 1940) (internal punctuation omitted)).

Opposer contends that Applicant’s first website design copied wording from Opposer’s website, suggesting Applicant’s willingness to trade on the goodwill associated with Opposer’s marks:

Opposer's Website	Applicant's Website
<u>"We make our bourbon carefully. Please enjoy it that way"</u>	<u>"We make our whiskey carefully. Please enjoy it one shot at a time"</u>
<u>"We've never been much for following the rules, but this one's a must. You must be of legal drinking age to surf our web site."</u>	<u>"We've never been much for following the rules, but this one's a must. You must be of legal drinking age to surf our web site."</u>

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Further, Opposer notes, Applicant's founder, "Mr. Parks acknowledges that, prior to founding Bowmaker's Whiskey Company, he had purchased MAKER'S MARK bourbon and attended a speech given by Bill Samuels, Jr., the former president and CEO of Maker's Mark Distillery, at which time he went out of his way to take a photograph with Mr. Samuels, Jr."⁸⁵

It is true that, prior to founding Applicant, Mr. Parks purchased MAKER'S MARK bourbon and attended a week-long distiller's course known as "Moonshine University," where he heard and met William Samuels Jr., the former president and Chief Executive Officer of Opposer.⁸⁶ And it is true, Applicant states, that Applicant's marketing consultant, Marcus Jenkins, a teetotaler:

made a *mock-up* of a non-functional age verification page for his private use. He acknowledged that he took wording from the Opposer's Website but only as a *mock-up* and subject to revision. He testified that this is often done in creating a new website by his firm and others. There was no intent that the page be made public, as is clear from the *errors* in typeface font on the mock-up, and to his knowledge the mock-up, which does not work, was not made public. Applicant's design firm's mock-up of one page of a

⁸⁴ Opposer's brief, 50 TTABVUE 50-51; Phillips decl. ¶¶ 36-42, exs. 6-7, 31 TTABVUE 9-10, 75-79; Jenkins dep., 39 TTABVUE 491.

⁸⁵ *Id.*, citing Parks dep. 11:7-12:25, 13:16-14:25, 51:19-52:3, 39 TTABVUE 15-18, 55-56.

⁸⁶ *Id.*

Website, which is not even a live Website, has no bearing on the issue of likelihood of confusion.⁸⁷

As the Federal Circuit has stated:

“[A]n inference of ‘bad faith’ requires something more than mere knowledge of a prior similar mark.” *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1565 (Fed. Cir. 1987). It requires an intent to confuse. *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 117 (2d Cir. 2009) (“[T]he ‘only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.’” (quoting 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23.113))....

Quiktrip W., Inc. v. Weigel Stores, Inc., 984 F.3d 1031, 2021 USPQ2d 35, *4 (Fed. Cir. 2021).

Mr. Jenkins’s testimony establishes that his intent was solely to create a mock-up web page for Applicant’s start-up company.⁸⁸ Even though he copied some of Opposer’s wording from its website, there is no evidence of intent on his part, or on Applicant’s part, to deceive the purchasing public whenever Applicant’s intended to begin advertising its product on its website.

We accordingly find the thirteenth *DuPont* factor neutral.

F. Conclusion

We have considered of all of the evidence of record and all of the arguments of the parties, as they pertain to the applicable *DuPont* likelihood of confusion factors. The parties’ goods, whiskey or bourbon whiskey, are identical, and are presumed to be

⁸⁷ Applicant’s brief, 51 TTABVUE 25.

⁸⁸ Jenkins dep. 15:8-19, 47:4-11, 67:22-69:1, 9-24, 70:19-23, 72:7-73:2, 23-24, 75:18-21, 76:11-13, 78:3-11, 86: 13-16, 89:12-15, 90:3-9, 13-22, 91:15-22, 98:17-99:1, 21-23, 100:4-6, 39 TTABVUE 373, 405, 425-28, 430-31, 433-34, 436, 444, 448-49, 456-58.

available in the same channels of trade to the same classes of consumers. Opposer's trademarks, MAKER'S MARK and MAKER'S, are conceptually arbitrary and famous for whiskey, particularly bourbon whiskey and thus are accorded a wider breadth of protection. In view thereof, and given our finding that the parties' marks are more similar than dissimilar, we conclude that Applicant's applied-for mark, BOWMAKER'S, is likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

V. Decision

The opposition is sustained on the ground of likelihood of confusion under Section 2(d). 15 U.S.C. § 1052(d).